
Res Adjudicata as a Ground of Rejection

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The question of Prior Adjudication in Patent Office cases may come before the Examiner in several different forms. It is a question which, more often than otherwise, he must raise and consider on his own motion.

The subject is not without difficulty even in ordinary legal procedure and in Patent Office practice the character of the rights involved and the intricacy of the proceedings further complicate the questions.

I shall not discuss the doctrine of *res adjudicata* broadly nor attempt definitions. A very clear statement of the doctrine in general may be found in the case of *Nesbit vs. Riverside*, 144 U. S., 610, a decision of the U. S. Supreme Court. Assuming a knowledge of these general principles I shall refer only to those phases of the subject which directly affect the Examiner's action on applications.

That the doctrine applies to Patent Office proceedings is now so well settled as scarcely to require citation of authority. This will affirmatively appear from a perusal of decisions cited below, notable among which, on this point, is the early decision of the Court of Appeals of the District of Columbia, *In re Barratt's Appeal*, decided in February, 1899 (87 O. G., 1075; 14 App. D. C., 255).

The simplest case of this nature in the Patent Office arises when a second application for the same invention as claimed in an earlier application is presented for examination—the earlier application having been finally disposed of as unpatentable. Such second application, can not, of course, be ignored; it must be acted upon. Furthermore, as was pointed out in the case of *Ex parte Kenny* (118 O. G., 2253), a decision by the Commissioner in 1905, it requires some examination to determine

that it is for the same invention as a prior case; but having found this to be true, that alone constitutes a sufficient ground for refusing the patent. In ruling upon this point in the Barratt case, above cited, the court said:

In what we have said we do not desire it to be understood that the Patent Office may not, if it thinks proper to do so, entertain and adjudicate a second application for a patent after the first application has been rejected. What we do decide is, that it is not incumbent upon the Office as a duty to entertain such applications, and that, if it refuses to entertain them, it has a perfect legal right to do so. An applicant is not legally aggrieved by such refusal.

This view had been taken by the Office long prior to that decision, as appears from the Commissioner's decision in *Ex parte Nichols* rendered in July, 1870 (C. D., 1870, 71). In 1872, however, two decisions were rendered by the Commissioner in which the position was taken that such second application should also be examined on its merits and the pertinent prior art applied to the claims. These were the cases of *Ex parte Le Van* (C. D., 1872, 40), and *Ex parte Gordon* (C. D., 1872, 145), decided in March and June, respectively, of 1872.

The latter case involved a so-called "renewal" under the act of 1870, which allowed six months for the renewal of certain applications rejected under former acts. The decision was based upon the terms of the act and therefore involves a special case having no real bearing on present cases.

The case of *Ex parte Le Van*, however, contains an argument for adding an action on the merits based on the prior art, which at first blush seems difficult to meet. It is this: if the case be rejected on *res adjudicata* alone the applicant must spend at least ten dollars additional in appeal fees before receiving an action on the merits, in the event the Examiner is wrong about the *res adjudicata*, whereas the statute provides for an examination on the merits for the first fee of fifteen dollars.

An answer to this argument, however, is to be found

in the fact that no one has a right to thrust useless work upon the Office merely by going through the form of filing applications. On this very point the Court of Appeals said, in the Barratt case cited:

If a second application could be regarded as proper, why not ten or twenty successive applications? Where are the applications to stop, and what would become of the public business, if it were in the power of one person to obstruct the operations of the Patent Office by repeated and persistent applications? These questions answer themselves.

As to the extra cost of ten dollars which may be involved, this is, in any event, not conclusive against the practice, for the same objection might be raised against the present practice in requiring division. That, too, may involve the expense of an appeal prior to a full action on the merits. Yet the present practice on division was instituted on no less an authority than that of the Supreme Court of the United States, whose decision in the Steinmetz case took the appeal in the first instance in such cases away from the Commissioner, where no fee was required, and sent it to the Board, where a fee is required.

On this point, it is also to be observed that the fee for appeal to the Board on the question of *res adjudicata* will cover any later appeal on the merits which may be taken to that tribunal, and such an appeal will almost certainly be necessary if the Examiner was originally of the opinion that the first and second applications were substantially identical.

Furthermore, the Examiner is unlikely to be in error in rejecting a case as *res adjudicata*. This ground of rejection is in fact applicable in relatively few cases. The tendency, if only from habit, is to examine a case on its merits and the doctrine of *res adjudicata* is not apt to be applied except in a clear case.

Returning, for a moment, to the course of the Office decisions on the subject, it may be noted that in the case of *Ex parte Arkell* in June, 1877 (C. D., 1877, 73), prior to the Barratt decision by the court, the Commissioner

returned to the holding of the Nichols case of 1870, and in *Ex parte* Kenny, in October, 1905 (118 O. G., 2253), and *Ex parte* Millet and Reed, in May, 1907 (128 O. G., 2836), following the Barratt case, the practice of disposing of the case on the ground of *res adjudicata* alone was fully and specifically authorized. A still later case by the Court of Appeals of the District, *In re* Edison, decided in February, 1908 (133 O. G., 1190; 30 App. D. C., 321), recognizes the practice as correct and quotes the Barratt case with approval, though the decision went off on another point.

Under the existing authorities, therefore, it seems clear that the Examiner *need* not go into the merits of the second application. On the other hand, there is no ruling to prevent his doing so if the ends of justice seem to require it.

As to the character of the application which is subject to this rejection, it is obvious that the second case need not be an exact duplicate of the earlier one. Even the claims need not be duplicates, as will appear from *Ex parte* Millett and Reed and *In re* Edison, cited. The criterion is identity of the inventions claimed in the two cases. The advantage to be gained in saving of time and labor by an application of the doctrine manifestly diminishes rapidly with the divergence in the disclosures of the two cases in question, because the difficulty of determining identity increases in proportion as it is concealed by changes in disclosure and terminology. Nevertheless, if prior adjudication is a pertinent ground of rejection in any case, it should be used by the Examiner at least in connection with other reasons of rejection so that in the event of an appeal on the merits the complete situation may be laid before the appellate tribunal.

Ordinarily, the saving of work by applying the doctrine is considerable, since, as a rule, the finding of identity is easy, while the examination and application of the prior art is difficult and time-consuming.

The most common occasion for rejecting claims as *res adjudicata* is after an interference. Rejections under rule 132 are, in fact, nothing more nor less than this, as, of course, are the rejections of other claims to the

same invention as that in issue, whether contained in the same application or a different one. That an interference constitutes an adjudication in favor of the winning party, of all subject-matter common to the cases involved, is a familiar rule of frequent applicability. It has been so firmly established by the decision in *Blackford vs. Wilder* (127 O. G., 1255; 25 App. D. C., 535), and subsequent decisions of the Court of Appeals as to need little comment. It should be observed, however, that this rule obtains even in cases where the claims in question could not ordinarily have been introduced into the existing interference; provided, only, that the party to be rejected had notice of the fact that the subject-matter of those claims was subject-matter common to the cases.

Thus, in the case of *Temple and Goodrum* (176 O. G., 526), the losing party to an interference thereafter presented claims which read upon his own case and upon the two other cases with which he had been involved, but which could not have been added to that interference because of a decision in another interference adverse to one of the other parties. These claims were held *res adjudicata* because the applicant, had he chosen to do so, could have presented and contested them with the party who could have made them, concurrently with the other interfering subject-matter, although, necessarily, in a separate two-party interference.

Again, in the *Marconi* case (179 O. G., 577; 38 App. D. C., 286), Marconi had two applications disclosing different species of the same invention. One went into interference with Babcock, on specific claims. The other went to issue on claims to the other species. Marconi lost the interference and then attempted to reissue the patented case with broad claims. When these met rejection on the ground of *res adjudicata*, he contended that they could not have been made and adjudicated in the interference because he could only have presented and patented those claims, if at all, in the first case to go to patent, under penalty of having them held invalid by the courts. Nevertheless the Court of Appeals held that he was concluded by the decision in the interference because he could, if necessary, have filed his re-issue application in time to have had it included in the

first interference, or could have prosecuted the claims through the interference in the pending case, and then transferred them to a reissue application.

A holding of similar effect was made in the case of *Robinson vs. Copeland* (187 O. G., 514 and 188 O. G., 1055).

Where the proceedings in an interference are such that the parties do not have the opportunity to inspect each others' applications, as where the interference is terminated by a concession of priority early in the proceedings, the doctrine of *res adjudicata* apparently does not apply to claims for matter not covered by the actual issue of that interference (*Felsing vs. Nelson*, 20 Gour., 6-12).

As a general thing the rule extends, however, not only to claims other than the precise issue but to claims presented in applications of other inventors than those actually involved in the interference when such applications or the inventions therein disclosed were controlled during the pendency of such interference by the same party in interest as the application actually involved. In the case of *Temple and Goodrum* above referred to the assignee of the losing party presented the claims of the issue in another application by a different inventor owned by the assignee at the time the interference was declared, and the Commissioner held that the prior adjudication was ground for rejecting such claims in that application as well as in the application which was unsuccessful in the interference.

This ruling was further extended in the case of *Frickey vs. Ogden*, decided in November, 1913, by the present Commissioner (199 O. G., 307). There, the second application in which the claims were presented, though owned by the same assignee, was not only by a different inventor but was not on file at the time the interference was declared. It appeared, however, that the assignee controlled both inventions at that time and could, had it desired, have filed the Frickey application in time to have it included in the interference, and it was held that the right of the assignee was *res adjudicata* and the interference was dissolved. This decision is not, of course, to be taken as holding that the doctrine will invariably be applied to such applications, because, like

other decisions, it is based upon a specific set of circumstances. It well illustrates, however, what a salutary use may be made of the principle, in Patent Office practice.

Formerly it was generally assumed that nothing short of a final rejection of claims *ex parte* or a formal award of priority in an interference was ground for a holding of *res adjudicata*.

In its decision in the Newcomb Motor case, however, rendered in 1908 (133 O. G., 1680; 30 App. D. C., 464), the Court of Appeals went farther than this. It held that a decision of the primary examiner rendered upon a motion to dissolve may, under certain circumstances, be a final adjudication. The circumstances in that case were briefly these: The Examiner held that Thompson had no right to make the claims, and dissolved the interference. An appeal from that decision was filed, but was afterward abandoned. Thompson then appealed the claims *ex parte*, and got them allowed. The Examiner thereupon redeclared the interference and Newcomb moved to dissolve, on the ground of *res adjudicata*. The Commissioner, when the question came before him, set aside all proceedings subsequent to the first decision of the Examiner dissolving the interference but ordered a reconsideration of that holding *inter partes*, with the right of appeal should the Examiner hold to his original opinion. The court's decision came on a petition for mandamus. It held that the Commissioner was without authority to order such a reconsideration and that Thompson was concluded, once for all, by the first decision of the Examiner when it became final by failure to prosecute an appeal therefrom.

It is important to note that the Examiner's holding was to the effect that the party had no right to make the claims and that the court apparently based its ruling upon the idea that this was equivalent to an award of priority to Newcomb so far as Thompson was concerned, inasmuch as a lack of right to make the claims is ground for awarding priority (*Podlesak vs. McInnerney*, 120 O. G., 2127; 26 App. D. C., 399). No dissolution of an interference on any other ground has, thus far, been held conclusive as to a party's right to a patent.

The *inter partes* consideration of the prior art, for instance, on motions to dissolve based on unpatentability is apt to be more thorough, if anything, than an *ex parte* consideration, and there seems to be no good reason why an *inter partes* determination that claims are unpatentable over the art should not be equally binding upon the parties, except that no *inter partes* appeal can be taken to the Court of Appeals on such a question under the present decisions of the court, and every applicant is, of course, entitled to the opportunity of appeal to that court upon the patentability of his claims before they can be held finally adjudicated against him (see *Gold vs. Gold*, 150 O. G., 570; 34 App. D. C., 229). Motions to dissolve, as such, can go no further than the Commissioner. Of course this objection applies also to motions to dissolve on the ground of no right to make the claims, but in the Newcomb Motor case, the court stated that the Commissioner undoubtedly had jurisdiction to go farther upon the decision of a motion based upon this ground and award priority to the party who could make the claims, and from such an award appeal could be taken to the Court of Appeals. Following this suggestion the Commissioner has in many cases awarded priority instead of dissolving the interference when a motion to dissolve, on the ground of no right to make the claims, has come before him, and the court has entertained appeals from such decisions (*Cosper vs. Gold and Gold*, 151 O. G., 194; 34 App. D. C., 194, and 168 O. G., 787; 36 App. D. C., 302).

As will appear from the cases which have been referred to it has frequently happened that the finding of *res adjudicata* has not been made until the case has become involved in an *inter partes* proceeding. This has usually happened, however, either because the rules which control such cases were in process of formation or because the Examiner failed to note the prior adjudication or disagreed as to its applicability. In all the various circumstances which have been here discussed it is the duty of the Examiner to use the prior adjudication as a ground of rejection in the *ex parte* treatment of the case, and to do so will often avoid the declaration of unnecessary interferences and their attendant complications.

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